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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD HORTON
and WILLIAM MILLER

Appeal 2009-003564
Application 10/523,342
Technology Center 2800

Decided: August 27, 2009

Before CATHERINE Q. TIMM, KAREN M. HASTINGS, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
decision rejecting claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. STATEMENT OF THE CASE

The invention relates to a low profile switch having a detent
mechanism on the outside of a panel on which the switch is mounted. The

switch has a single substantially horizontal spring as part of the detent mechanism, and the detent sub-assembly is substantially covered by the knob. Other aspects include devices and methods of use in which the switch operates independently of the knob. (Br. 2.) Claims 1, 9, 10, and 11 are illustrative of the subject matter on appeal:

1. A rotary switch mounted above and below a panel, comprising:

a sealing member disposed between a portion of the switch and an underside of the panel;

a detent sub-assembly located entirely above the panel; and

a knob that substantially covers the detent sub-assembly wherein the detent sub-assembly is enclosed and operates independent of the knob and further wherein only a bushing and shaft extend through the panel.

9. A rotary switch for mounting on an underside of a_[sic] panel, the rotary switch having a fully enclosed detent sub-assembly on a user's side of the panel, and a sealing member disposed between the sub-assembly and an underside of the panel.

10. A method of selecting an electrical circuit using a panel mounted rotary switch, comprising:

providing a shaft that cooperates with an independent detent sub-assembly located entirely on a user's side of the panel, wherein the shaft is coupled to an electrical connection on an underside of the panel and further wherein the detent sub-assembly is completely on one side of the panel and the rotary switch is located on the underside of the panel and not within the detent sub-assembly;

a sealing member disposed between a portion of the switch and an underside of the panel; and

selecting the circuit by rotating the shaft thereby causing the electrical connection to contact a printed circuit board in a configuration approximating the circuit.

11. A panel mounted rotary switch, comprising:
 - an independent detent sub-assembly located on a user's side of a panel;
 - a sealing member disposed between a portion of the switch and an underside of the panel;
 - a knob that substantially covers the detent sub-assembly; and
 - a shaft that cooperates with the detent sub-assembly to manipulate an electrical connection on an underside of the panel.

Appellants request review of the rejections maintained by the Examiner, namely, the rejection of claims 1-8, and 12 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention, and the rejection of claims 1-12 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,857,677, issued August 15, 1989, to Tanaka et al. ("Tanaka") in view of U.S. Patent No. 3,311,718, issued March 28, 1967, to Allison et al. ("Allison").

II. § 112, SECOND PARAGRAPH REJECTION

A. ISSUE ON APPEAL

The Examiner contends that the meaning of the phrase "wherein the detent subassembly is enclosed and operates independent of the knob" is not clear because the limitation is contrary to Appellants' disclosure (Ans. 3).

Appellants respond by quoting the paragraph spanning pages 3 to 4 of the Specification and stating that "the specification supports the claims that the detent sub-assembly is enclosed and operated independent of the knob" (Br. 7).

The first issue on appeal arising from the contentions of Appellants and the Examiner is: have Appellants shown that the Examiner reversibly erred in determining that the meaning of the phrase “wherein the detent sub-assembly is enclosed and operates independently of the knob” of claim 1 is uncertain and thus indefinite?

B. FACTUAL FINDINGS

The following Findings of Fact (FF) are relevant to deciding the above identified issue on appeal:

1. The Examiner finds that while the detent sub-assembly can be considered to be enclosed independent of the knob, operation of the detent sub-assembly requires the shaft to be rotated by the knob (Ans. 6-7).

2. Appellants do not contest this finding by the Examiner (*see generally* Br.).

C. PRINCIPLES OF LAW

35 U.S.C. § 112, ¶ 2 “puts the burden of precise claim drafting squarely on the applicant.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). Therefore, when an examiner advances a reasonable basis to believe that those of ordinary skill in the art would not be able to determine the scope of the claim, the burden shifts to the applicant to show otherwise. *Id.* at 1054 (“Once the PTO has made an initial determination that specified claims are not patentable . . . , the burden of production falls upon the applicant to establish entitlement to a patent.”) (citations omitted).

The specification informs the meaning of the claims. *See Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) (“The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light

of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.”) (citation omitted). Thus, claims may be indefinite when a conflict between the claimed subject matter and the specification disclosure renders the scope of the claims uncertain. *See In re Cohn*, 438 F.2d 989, 993 (CCPA 1971) (reading the claims in light of the disclosure results in “an inexplicable inconsistency . . . requiring that the rejection under 35 U.S.C. 112 on the grounds of indefiniteness be sustained”).

D. ANALYSIS

The Examiner’s finds that the detent sub-assembly cannot be operated without the knob (FF 1). Since the Examiner's finding is reasonable and the Appellants have not challenged it (FF 2), we accept it as fact. *See In re Kunzmann*, 326 F.2d 424, 425 n.3 (CCPA 1964). Thus, Appellants’ invention, as described by Appellants’ Specification, conflicts with the requirement in claim 1 that the detent sub-assembly “operates independently” from the knob. We agree with the Examiner that this conflict renders the meaning of claim 1 uncertain and indefinite.

Accordingly, Appellants have not shown that the Examiner reversibly erred in determining that the meaning of the phrase “wherein the detent sub-assembly is enclosed and operates independently of the knob” of claim 1 is uncertain and thus indefinite.

II. SECOND REJECTION

A. ISSUE ON APPEAL

With respect to the obviousness rejection of claims 1-8 and 12, the main dispute between the Examiner and Appellant centers on the question of whether the combined teachings of Tanaka and Allison suggest a switch

wherein "the detent subassembly is enclosed and operates independently of the knob" as recited in claim 1 (*see* Br. 8-9; Ans. 7-8). In order to answer this question, it is necessary to understand the scope of what is claimed.

Above, we determined that claim 1 does not particularly point out and distinctly claim the subject matter which applicant regards as his invention as required by 35 U.S.C. § 112, ¶ 2. Thus, the scope of claims 1-8, and 12 cannot be ascertained without considerable speculation, and we cannot decide the question regarding the reason to combine. Therefore, we procedurally reverse the obviousness rejection with respect to claims 1-8, and 12. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962) (reversing § 103 rejection because the rejection was based on considerable speculation as to the meaning of terms of the claims and assumptions as to their scope). We emphasize that this is a technical reversal of the rejection under 35 U.S.C. § 103(a) and not a reversal based upon the merits of the rejection.

However, claims 9-11 do not contain the indefinite language directed to independent operation of the detent sub-assembly. Therefore, we are able to consider the merits of the obviousness rejection as to claims 9-11.

With respect to claims 9-11, Appellants state that Allison does not teach or suggest a method of selecting an electrical circuit as recited in claim 10 and that "neither *Tanaka et al.* nor *Allison* disclose, teach or suggest what is recited in independent Claims 1, 10 and 11." Appellants also state that "*Tanaka* does not disclose the shaft and bushing extending through the panel to attach the detent sub-assembly to the switch. (Br. 8.).

The Examiner contends that it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide a seal between the panel and the switch and design the switch so that only a

bushing and shaft extends through the panel of Tanaka, as suggested by Allison, in order to prevent dirt entering the switch area below the panel and to simplify the switch design (Ans. 5).

An issue on appeal arising from the contentions of Appellants and the Examiner is: have Appellants shown that the Examiner reversibly erred in determining that claims 9-11 would have been obvious over the combined teachings of Tanaka and Allison?

B. FACTUAL FINDINGS

The following additional Findings of Fact are relevant to deciding the above identified issue on appeal:

3. The Examiner relies on Tanaka to teach a separately disclosed detent sub-assembly on a user's side of a panel and a switch on the opposite side of the panel. (Ans. 4-5; Tanaka, Figure 3).

4. The Examiner relies on Allison to teach the claimed sealing member and a shaft and bushing extending through a panel. (Ans. 5; Allison, Figure 2).

C. PRINCIPLES OF LAW

“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”

In re Kahn, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (emphasis omitted).

However, the Court of Appeals for the Federal Circuit has determined that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

D. ANALYSIS

Appellants assert that Tanaka and Allison do not *separately* teach the claimed invention. Yet, the Examiner clearly relies on combining the teachings of Tanaka and Allison to arrive at the claimed invention (FF 3-4; Ans. 5). Thus, Appellants do not address the Examiner's specific positions articulated in the Answer or explain why these positions are deficient.

Further, Appellants merely assert that the claim elements are not taught by the references, despite the Examiner's explicit findings to the contrary (FF 3-4). Such statements fall well short of rebutting the Examiner's prima facie case of obviousness - a position that Appellants have provided us no grounds to find unreasonable. 37 C.F.R. § 41.37(c)(1)(vii) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.").

Accordingly, Appellants have not shown that the Examiner reversibly erred in determining that claims 9-11 are obvious over the combined teachings of Tanaka and Allison.

IV. CONCLUSION

For the reasons indicated above, we sustain the rejection of claims 1-8, and 12 under 35 U.S.C. § 112, second paragraph and the rejection of claims 9-11 under 35 U.S.C. § 103(a) as obvious over Tanaka in view of Allison. However, we do not sustain the rejection of claims 1-8, and 12 under 35 U.S.C. § 103(a) as obvious over Tanaka in view of Allison.

V. DECISION

We affirm the Examiner's decision.

Appeal 2009-003564
Application 10/523,342

VI. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a)(1)(v) (2008).

AFFIRMED

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